



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Elisabeth Wolpert et al.

Application No.: 09/319,736

Filing Date: August 2, 1999

Group Art Unit: 1642

Examiner: KAREN A CANELLA

Confirmation No.: 3510

Title: THERAPEUTIC APPLICATIONS OF ANTIGENS OR EPITOPES ASSOCIATED WITH IMPAIRED CELLULAR PEPTIDE PROCESSING, E.G. EXPRESSED ON RMA-S CELLS TRANSFECTED WITH A B7-1 GENE

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

☐ A Petition for Extension of Time is also enclosed.

☐ Terminal Disclaimer(s) and the ☐ \$65.00 (2814) ☐ \$130.00 (1814) fee per Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.

☐ Also enclosed is/are _____

☐ Small entity status is hereby claimed.

☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$395.00 (2801) ☐ \$790.00 (1801) fee due under 37 C.F.R. § 1.17(e).

☐ Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.

☐ Applicant(s) previously submitted _____

_____ on _____
for which continued examination is requested.

☐ Applicant(s) requests suspension of action by the Office until at least _____, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.

☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below.

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims	20	MINUS 20 =	0	x \$50.00 (1202) =	\$ 0.00
Independent Claims	5	MINUS 5 =	0	x \$200.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$360.00 (1203)					
Total Claim Amendment Fee					\$ 0.00
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					\$ 0.00
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0.00

- ☐ A check in the amount of _____ is enclosed for the fee due.
- ☐ Charge _____ to Deposit Account No. 02-4800.
- ☐ Charge _____ to credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

By



Christopher L. North, Ph.D.
Registration No. 50,433

Date: May 18, 2005



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Elisabeth Wolpert et al.) Group Art Unit: 1642
Application No.: 09/319,736) Examiner: KAREN A. CANELLA, Ph.D.
Filed: August 2, 1999) Confirmation No.: 3510
For: THERAPEUTIC APPLICATIONS OF)
ANTIGENS OR EPITOPES ASSOCIATED)
WITH IMPAIRED CELLULAR PEPTIDE)
PROCESSING, E.G. EXPRESSED ON)
RMA-S CELLS TRANSFECTED WITH A)
B7-1 GENE)

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed April 18, 2005 vacating the Restriction Requirement mailed June 2, 2004 and setting forth a new restriction requirement, Applicants hereby make the following election of a species for examination purposes with traverse. It is noted that as the Restriction Requirement mailed June 2, 2004 has been vacated, Applicants' Response thereto, filed November 30, 2004, has been rendered moot and accordingly of no effect.

The present restriction requirement is respectfully traversed, at least because "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803. To support a restriction requirement, "Examiners must provide reasons and/or examples to support conclusions." *Id.* For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in M.P.E.P. § 808.02. *Id.* In the present case, the Examiner has not alleged any of these bases for a *prima facie* showing of a serious burden. Moreover, M.P.E.P. § 803 makes it clear that "[t]hat *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant." This means that

Applicant[s] must be afforded an opportunity to respond to the Examiner's alleged *prima facie* basis for finding a serious burden, which is not possible where no basis has been alleged. Applicants respectfully submit that there would be such substantial overlap of a search directed to any of the delimited species with a search of any of the other species that no serious burden can exist.

Furthermore, the species which have been delimited as (a)-(e) are recited together, and the species which have been delimited as (f)-(j) are recited together, in Markush-type dependent claims. M.P.E.P. § 803.02 states that "[i]f the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions." The Examiner has not shown why these Markush-type groupings are both so numerous and so unrelated that a search and examination of the entire claim can be made without serious burden. Applicants respectfully submit that the members of these Markush-type groupings are neither so numerous nor so unrelated that a search and examination of the entire claims can be made without serious burden.

In view of the foregoing, Applicants hereby elect species (c) a gene encoding a TAP inhibitor with traverse. It is understood that at the least, after a finding that a generic claim is allowable, Applicants are entitled to consideration of additional species as acknowledged in the Office Action and as set forth in M.P.E.P. § 808.01 with reference to M.P.E.P. § 809.02 and also in view of the procedure described in M.P.E.P. § 803.02 with respect to Markush-type claims.

In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited.

In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned concerning such questions so that prosecution of this application may be expedited.

The Director is hereby authorized to charge any appropriate fees that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: May 18, 2005

By:



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